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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,651	06/27/2003	Mark R. Albrecht	171006-0001U3	7032
24267 7590 03/17/2009 CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210				
EXAMINER				
FRENEL, VANEL				
ART UNIT		PAPER NUMBER		
3687				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,651

Applicant(s)

ALBRECHT, MARK R.

Examiner

VANDEL FRENEL

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 31, 32 and 34-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 31-32, 43-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 12/16/08. Claims 13-30 and 33 have been cancelled. Claims 1, 31, 32, 34 and 48 have been amended. Claims 49-52 have been newly added. Claims 1-12, 31-32 and 34-52 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12, 31-32 and 34-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (6,473,741) in view of Carver (2004/0078307).

As per claims 1-12, 31-32 and 34-52, Baker discloses for plural respective direct services providers, loading, onto a remotely accessible part of a common host server located in a given country, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the client specific financial files and corresponding reference materials (See Baker, Co1.10, lines 56-67 to Co1.11, line 20); and monitoring and reporting the status of the tax return preparation and of the other financial service projects (See Baker, Co1.12, lines 41-67).

Baker does not explicitly disclose a financial services outsourcing method for facilitating a direct service provider's management of human resources for providing

financial services to numerous clients, the financial services being outsourced to an outsourcing group abroad, the method comprising: prioritizing tax returns for outsourcing, "wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced"; retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country; providing the outsourced personnel limited access to the server; the outsourced personnel performing the tax return preparation services during the tax season in the given year and performing the financial service projects during a different season of the given year through a remote limited access client located in the outsource country.

However, these features are known in the art, as evidenced by Carver. In particular, Carver suggests a financial services outsourcing method for facilitating a direct service provider's management of human resources for providing financial services to numerous clients, the financial services being outsourced to an outsourcing group abroad, the method comprising: prioritizing tax returns for outsourcing (See Carver, Page 4, Paragraph 0027); "wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027; Page 5, Paragraph 0030);" retaining outsourced personnel to perform tax return preparation services for clients of the direct

service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country (See Carver, Page 4, Paragraph 0027); providing the outsourced personnel limited access to the server (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027); the outsourced personnel performing the tax return preparation services during the tax season in the given year and performing the financial service projects during a different season of the given year through a remote limited access client located in the outsource country (See Carver, Page 4, Paragraph 0027).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Carver within the system of Baker with the motivation of guarantying security of all identifying data and characteristics is provided, and a user may utilize fictional euphemisms or other coded information as desired. Password protection is required of all users and accounts (See Carver, Page 1, Paragraph 0010).

As per claim 2, Baker discloses the method wherein the tax return preparation services comprise individual tax return preparation services (See Baker, Col.10, lines 56-67 to Col.11, line 2).

As per claim 3, Carver discloses the method wherein the tax returns and other financial services are outsourced through an intermediary firm to the outsourced personnel (See Carver, Page 4, Paragraph 0027).

As per claim 4, Carver discloses the method wherein the other financial service projects comprise bookkeeping projects (See Carver, Page 3, Paragraph 0020).

As per claim 5, Carver discloses the method further comprising the intermediary service firm interacting with the outsourced personnel through use of a servicing computer system, and interacting with the plural direct service providers through use of the servicing computer system (See Craver, Page 4, Paragraph 0025).

As per claim 6, Carver discloses the method wherein the direct service providers comprise accounting firms (See Craver, Page 4, Paragraphs 0025-0026).

As per claim 7, Carver discloses the method wherein the host server provides limited screen shot access to the remote client computer of information concerning the client specific financial files and corresponding reference materials (See Carver, Page 4, Paragraph 0026).

As per claim 8, Carver discloses the method wherein the host server comprises a CITRIX server (See Carver, Page 2, Paragraph 0016).

As per claim 9, Carver discloses the method wherein the host server provides limited screen shot access to the remote client computer of information concerning the client specific financial files and corresponding reference materials (See Carver, Page 4, Paragraph 0026).

As per claim 10, Carver discloses the method according to claim 9, wherein the host server comprises a CITRIX server (See Carver, Page 2, Paragraph 0016).

As per claim 11, Carver discloses the method wherein the host server comprises an ASP server running tax software for use by plural independent direct service providers provided with access to the ASP server (See Carver, Page 2, Paragraphs 0016-0017).

As per claim 12, Carver discloses the method wherein the host server comprises an ASP server running tax software for use by plural independent direct service providers provided with access to the ASP server (See Carver, Page 2, Paragraphs 0016-0017).

As per the newly added claim 35, Carver discloses the method further comprising: interviewing one or more tax filers (See Carver, Page 5, Paragraph 0030);

and obtaining information from the one or more tax filers (See Carver, Page 4, Paragraphs 0027-0028).

As per the newly claim 36, Carver discloses the method wherein the information further comprises: prior year return information (See Carver, Page 1, Paragraph 0006); and supporting documentation of the prior year return information (See Carver, Page 1, Paragraph 0006).

As per the newly claim 37, Carver discloses the method further comprising: assigning, to an individual preparer of the outsourced personnel, one or more tax returns of the tax returns prioritized for outsourcing (See Carver, Page 4, Paragraph 0027); annotating, by the individual preparer, each of the one or more tax returns assigned to the individual preparer (See Carver, Page 4, Paragraphs 0025-0026); and completing, by the individual preparer, each of the one or more tax returns assigned to the individual preparer (See Carver, Page 5, Paragraph 0030).

As per the newly added claim 38, Carver discloses the method further comprising: assigning, at a first local time, the tax returns prioritized for outsourcing, the first local time corresponding to an evening time in the United States (See Carver, Page 4, Paragraph 0027); and completing, before a second local time, the tax returns prioritized for outsourcing, the second local time corresponding to the first morning time

in the United States after the evening time in the United States (See Carver, Page 4, Paragraph 0027).

As per the newly added claim 39, Carver discloses the method further comprising: reviewing, by a tax department or by a project manager, the completed tax returns prioritized for outsourcing (See Carver, Page 4, Paragraph 0027).

As per the newly added claim 40, Carver discloses the method further comprising: generating a list of questions, the list of questions comprising missing information, the missing information required to complete a tax return of the tax returns prioritized for outsourcing (See Carver, Page 5, Paragraphs 0033-0034).

As per the newly added claim 42, Carver discloses the method wherein the contacting of the tax filer is outsourced (See Carver, Page 4, Paragraph 0027).

As per the newly added claim 43, Carver discloses the method wherein the transmitting of the missing information to the tax return preparer occurs by a computer network (See Carver, Page 2, Paragraph 0016).

As per the newly added claim 44, Carver discloses the method wherein the outsourcing of the tax return is determined by prioritizing of rates and margins (See Carver, Page 2, Paragraph 0017; Page 4, Paragraph 0026).

As per the newly added claim 45, Carver discloses the method further comprising outsourcing of bookkeeping of the information concerning the tax filer (See Carver, Page 3, Paragraph 0020).

As per the newly added claim 46, Carver discloses the method further comprising monitoring work time of the tax preparer (See Carver, Page 4, Paragraph 0027).

As per the newly added claim 47, Carver discloses the method of claim 41 further comprising instructing the tax preparer to perform other tasks, the other tasks not related to preparing the tax return (See Carver, Page 4, Paragraph 0027).

As per claim 49, Carver discloses the method wherein the lower priority tax return is a tax return with a smaller price than that of the higher priority tax return with a larger price (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027).

As per claim 50, Carver discloses the method wherein a tax return with lower priority is a tax return for an individual tax filer (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027).

As per claim 51, Carver discloses the method wherein the higher priority tax return is a tax return with a higher price than that of the priority tax return with a smaller price (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027).

As per claim 52, Carver discloses the method wherein a tax return with a higher priority is a tax return for a corporation (See Carver, Page 2, Paragraph 0016; Page 4, Paragraph 0027).

Response to Arguments

4. Applicant's arguments filed on 12/16/08 with respect to claims 1-12, 31, 32, and 34-52 have been fully considered but they are not persuasive.

(A) At pages 9-14 of the response filed on 12/16/08, Applicant's argues the followings:

(i) Baker and Carver either alone or in combination fails to suggest the claimed invention.

(ii) Carver fails to teach or suggest Applicant's claimed novel "outsourcing tax return preparation services".

(iii) Baker and Carver do not suggest "prioritizing tax returns for outsourcing, wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced".

(B) With respect to Applicant's first argument, Examiner respectfully submitted that that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111 (b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. In *re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in In re DeLisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in In re Lamberti et al, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and (iii) the question is not express teaching of references, but what they would suggest. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second and third arguments, the Examiner respectfully submitted that He relied upon the teaching of Carver for such a feature (See Page 4, Paragraph 0027; Page 5, Paragraph 0030). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches system and method for managing login resources for the submission and performance of engagements (7,454,371).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nanel Frenel/

Examiner, Art Unit 3687

February 25, 2009